APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/464,866	12/16/1999	RICHARD BRYAN SAGAR	PHA-23.884	8189

			EXAMINER
24738	7590	09/20/2004	D AGOSTA, STEPHEN M

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ART UNIT	PAPER NUMBER
2683	

DATE MAILED: 09/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/464,866	SAGAR, RICHARD BRYAN
	Examiner	Art Unit	
	Stephen M. D'Agosta	2683	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>11 August 2004</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
  closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2-7 and 9-20* is/are pending in the application.

  4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *18-20* is/are allowed.

6)☒ Claim(s) *2-7 and 9-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

  a)☐ All b)☐ Some * c)☐ None of:

  1.☐ Certified copies of the priority documents have been received.

  2.☐ Certified copies of the priority documents have been received in Application No. _____.

  3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
    application from the International Bureau (PCT Rule 17.2(a)).

  * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
  Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
  Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 8-11-04 have been fully considered but they are not

persuasive.

1. Claims 18-20 are allowed.

2. In response to applicant's argument that there is no suggestion to combine

the references, the examiner recognizes that obviousness can only be established by

combining or modifying the teachings of the prior art to produce the claimed invention

where there is some teaching, suggestion, or motivation to do so found either in the

references themselves or in the knowledge generally available to one of ordinary skill in

the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re*

Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Mendez teaches

much of the independent claim(s) but Is sllent on:

> 1. The second terminal being a MOBILE terminal,
> 2. Associating the data with a particular user,
> 3. The server determining which from a plurality of corresponding and non-
> corresponding mobile terminals is a corresponding àecond mobile terminal and
> selectively transferring the conveded data automatically into the second database for
> use by the second application.
> For #1 - While Mendez does not specifically state that he excludes the second
> computer (ej. the LAN-connected computer, figure 1, #134) from being wireless, he
> gives an example that the system can connect/update four devices/sites such as work,
> home, offsite and global (C2, L18-24) which would provide for wirelqss connectivity.
> The examiner notes that Wireless LAN'S (WGN's) are well known in the art and can
> reqlace the 'lwired" desktop computer shown (see C1 1, L15-29) and Mendez teaches
> the LAN computer having a Base Station (figure 1, #146) which implies a wireless
> Onnection.
> For #2 - Mendez teaches a LANAAN configuration (figure 1 shows computers
> and Firewalls) along with use of the Internet (C2, L60-67) which inherently requires
> TCP/IP and a LAN administrator who sets up the system for access by only authorizqd
> users. Further to this point, Mendez teaches "automatic synchronization" (abstract)
> betwéen users and the global computer which inherently requires the system to
> associate various files to various users.

For #3 - Mendez teaches a LANAAN system using TCP/IP which suppod unicast/multicast operations and would be able to determine from a plurality of corresponding and non-corresponding terminals (eg. setup a multicast group so that only a select plurality of users receive synchronization when a certain file is updated). Mendez also teaches "automatic synchronization" (abstract) between users and the global computer which inherently requires the system to associate various files to various users. Lastly **Segur** teaches (figure 6 and C3, L35-65) that the server analyzes the sender ID which allows the user to select which messages to download. Hence, the examiner interprets Mendez's automatic synchronization of reformatted files between two users combined with Segur's ability to identify the sender of each messages in the receiver's inbox as reading on "selectively transferring the conveded data automatically into the second database for use by the second application".

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Mendez, such that the second terminal is a mobile terminal and data is associated with a padicular user and selectively transferred into the second database, to provide means for both users to be wirelessly connected for range of freedom whereby data can be updated and automatically downloaded to those users) who require said data for their daily tasks.

Hence the examiner shows that Mendez is silent on several features, an explanation as to how these features are interpreted and why/how he (and Segur) remedy the failings. Secondly, the process of automating something that is manual is not novel (and can be viewed as a design choice). Lastly, both pieces of prior art are from the same field of endeavor and solve similar problems as that of the applicant. Therefore, the examiner has not used hindsight reasoning and the combination affords a valid rejection.

-- The previous rejection is attached for informational purposes only (see below).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

Claims 2-7 and 9-17 rejected under 35 U.S.C. 103(a) as being unpatentable

over Mendez et al US 6,023,708 and further in view of Segur US 6,212,550.

As per **claim 2**, Mendez teaches the method of claim 16 wherein:
The first apparatus performs first communication functionalities using data stored
in a first database (remote terminal is a laptop/PDA, C3, L57-65 which can host
database applications and Microsoft application(s) are disclosed by Mendez, C3, L18-
20 and stored data can be a telephone directory), and
The second apparatus performs second communication functionalities using data
stored in a second database (C3, L6 to C4, L23 - global server reformats data received
from remote terminal and sends it to the desktop computer/etc. – said data may be a
telephone directory which the computer user may use to make a wired/wireless call
and/or Internet Phone call via VoIP as is known in the art and uses the computer as a
phone).

As per **claim 3**, Mendez teaches claim 16 wherein each of the first and second
apparatus comprise as least one of the following, a PDA with Internet capability, a
mobile phone, a wired phone and a pager (C3, L57-65 teaches wired/wireless phone
and PDA. One skilled would also support a pager).

As per **claim 4**, Mendez teaches claim 16 wherein the information is uploaded
via the Internet from the first apparatus to the server (C2, L60 to C65 teaches remote
terminal connecting to global server via Internet).

As per **claim 5**, Mendez teaches claim 16 wherein the information is downloaded
via the Internet to the second apparatus (C2, L65-67 teaches connecting from global
server to a desktop via the Internet).

As per **claim 6**, Mendez teaches claim 16 wherein the server keeps a copy of the
information uploaded (C3, L65 to C4, L23 teaches global server storing a copy of data
in a "global format").

As per **claim 7**, Mendez teaches claim 16 **but is silent on** wherein the manipulating comprise at least one of the following: selectively extracting data from the uploaded information and converting a format.

Segur teaches transmitting data from the server to the user and editing emails (eg. extracting only relevant data) before sending to a pager (most likely to cut down on the size of the message being sent to the pager).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Mendez, such that manipulating comprises selectively extracting data from the uploaded information and converting a format, to provide means for determining and extracting only important/relevant information when sending data between two users to downsize message content to a user who has limited reception capabilities.

As per **claim 9**, Mendez teaches claim 17 **but is silent on** wherein the server is enabled to manipulate by at least one of the following: selectively extracting data from the information and converting a format.

Segur teaches transmitting data from the server to the user and editing emails (eg. extracting only relevant data) before sending to a pager (most likely to cut down on the size of the message being sent to the pager).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Mendez, such that manipulating comprises selectively extracting data from the uploaded information and converting a format, to provide means for determining and extracting only important/relevant information when sending data between two users to downsize message content to a user who has limited reception capabilities.

As per **claim 10**, Mendez teaches the system of claim 17, wherein:

The first apparatus has a first communications capability based on a first database (figure 1 shows remote terminal (eg. wireless phone/PDA, C3, L57-65) which would use both a phone directory and TCP/IP address for communications);

The second apparatus has a second communications capability based on a second database (figure 1 shows a desktop computer which would use TCP/IP addresses and/or DNS "dot com" addresses for communications and MAY have VoIP capability for voice connectivity via Internet);

The first database relates to a first communications directory (data from first user's computer would be both a telephone directory and TCP/IP "directory" for communications as can be stored in a Microsoft WORD file, C3, L18-20), and

The second database relates to a second communications directory (Desktop computer would store both TCP/IP Addresses and/or DNS "dot com" addresses and may include "telephone numbers" for VoIP connectivity).

The examiner notes that the global server would provide reformatting/translation between the myriad of communications databases (C3, L66 to C4, L23).

As per **claim 11**, Mendez teaches a method for transferring data in a database of a first mobile terminal (figure 1, #102 shows a remote/mobile terminal while #116 shows Format B workspace data which can be any data, including database data) to one or more second terminals (C1, L59 to C2, L23 teaches synchronizing data among four sites), comprising:

Providing a common server accessible to a first mobile terminal and a corresponding second terminal (figure 1, #112 shows a global server with global translator, #120), the terminals being remote from each other and the server (figure 1 shows a Remote Terminal #102 and a Desktop computer #134 which are remote from each other), the first mobile terminal having at least a first application and associated first database for use in the first mobile terminal (C3, L41-65 teaches the remote/first terminal being a PDA/Laptop which inherently host a myriad of applications (eg. Microsoft BackOffice) to include database applications (eg. Microsoft Access), and the second terminal having at least a second application and associated second database for use in the second mobile terminal (C3, L4-29 teaches a desktop computer #134 which hosts/runs applications and manipulates/stores data similar to the remote/first terminal).

Enabling the upload of data from the first application's first database to the common server (figure 1 shows comm. link #104 to Global Format Workspace Data/Server #120 and #106, Global Translator #122 and C3, L66 to C4, L23),

Converting the uploaded data to conform to the format (C3, L66 to C4, L23 teaches the global server reformatting data from Format A to Format B), and

But is silent on

1. The second terminal being a MOBILE terminal,

2. Associating the data with a particular user,

3. The server determining which from a plurality of corresponding and non-corresponding mobile terminals is a corresponding second mobile terminal and selectively transferring the converted data automatically into the second database for use by the second application.

For #1 - While Mendez does not specifically state that he excludes the second computer (eg. the LAN-connected computer, figure 1, #134) from being wireless, he gives an example that the system can connect/update four devices/sites such as work, home, offsite and global (C2, L18-24) which would provide for wireless connectivity. The examiner notes that Wireless LAN's (WLAN's) are well known in the art and can replace the "wired" desktop computer shown (see C11, L15-29) and Mendez teaches the LAN computer having a Base Station (figure 1, #146) which implies a wireless connection.

For #2 – Mendez teaches a LAN/WAN configuration (figure 1 shows computers and Firewalls) along with use of the Internet (C2, L60-67) which inherently requires TCP/IP and a LAN administrator who sets up the system for access by only authorized users. Further to this point, Mendez teaches "automatic synchronization" (abstract) between users and the global computer which inherently requires the system to associate various files to various users.

For #3 – Mendez teaches a LAN/WAN system using TCP/IP which support unicast/multicast operations and would be able to determine from a plurality of corresponding and non-corresponding terminals (eg. setup a multicast group so that only a select plurality of users receive synchronization when a certain file is updated). Mendez also teaches "automatic synchronization" (abstract) between users and the global computer which inherently requires the system to associate various files to various users. Lastly **Segur** teaches (figure 6 and C3, L35-65) that the server analyzes the sender ID which allows the user to select which messages to download. Hence, the examiner interprets Mendez's automatic synchronization of reformatted files between two users <u>combined with</u> Segur's ability to identify the sender of each messages in the receiver's inbox as reading on "selectively transferring the converted data automatically into the second database for use by the second application".

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Mendez, such that the second terminal is a mobile terminal and data is associated with a particular user and selectively transferred into the second database, to provide means for both users to be wirelessly connected for range of freedom whereby data can be updated and automatically downloaded to those user(s) who require said data for their daily tasks.

As per **claim 12**, Mendez teaches claim 11 **but is silent on** wherein the first database includes a telephone directory.

Mendez teaches use of desktop/laptop computers (C3, L9 and C3, L57-65) and applications such as Microsoft WORD (C3, L18-20) which can store a telephone directory. Hence, one skilled would use Microsoft WORD to generate a telephone directory and transfer it to other users within the LAN/WAN via the global server which would reformat the directory based upon each user's individual application set running on his/her computer/laptop.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Mendez, such that the first database includes a telephone directory, to provide means for a first user to generate an important document such as a company telephone directory and send it to his/her peers without regard to which computer/laptop said peers use since the global server will reformat it as needed.

As per **claim 13**, Mendez teaches claim 11 **but is silent on** wherein the second database includes a telephone directory.

Mendez teaches use of desktop/laptop computers (C3, L9 and C3, L57-65) and applications such as Microsoft WORD (C3, L18-20) which can store a telephone directory. Hence, one skilled would use Microsoft WORD to generate a telephone directory and transfer it to other users within the LAN/WAN via the global server which would reformat the directory based upon each user's individual application set running on his/her computer/laptop.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Mendez, such that the second database includes a telephone directory, to provide means for a second user to receive an important

document such as a company telephone directory which has been reformatted by a global server and was originally sent from a peer.

As per **claim 14**, Mendez teaches claim 11 wherein the first apparatus and the second apparatus includes one or more of a PDA, pager and a cellular telephone (C3, L57-65 teaches a (cellular/wired) smart telephone and a PDA).

As per **claim 15**, Mendez teaches claim 11 **but is silent on** wherein the manipulated information includes one or more telephone numbers automatically retrievable by the second apparatus to initiate a telephone call from the second apparatus.

Firstly, Mendez teaches use of desktop/laptop computers (C3, L9 and C3, L57-65) and applications such as Microsoft WORD (C3, L18-20) which can store a telephone directory. Hence, one skilled would use Microsoft WORD to generate a telephone directory and transfer it to other users within the LAN/WAN via the global server which would reformat the directory based upon each user's individual application set running on his/her computer/laptop.

Secondly, Mendez teaches "automatic synchronization" (abstract) which the examiner interprets as providing synchronization if/when a file important to the user changes on the global server (eg. automatically update all clients when a file is updated on the global sever). Hence, if a client were to change a phone number and upload it to the global server, the global server would then download this latest information to any/all clients who need to receive the updated information.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Mendez, such that the manipulated information includes one or more telephone numbers automatically retrievable by the second apparatus to initiate a telephone call from the second apparatus, to provide the latest automatically synchronized data to each user as updates occur thus preventing stale data from being used.

As per **claim 16**, Mendez teaches a method comprising:

Providing a server accessible by a plurality of sets of corresponding apparatuses (figure 1 shows a remote terminal #102 connecting to a global server #106 which connects to a corresponding apparatus desktop computer #134), the apparatuses being remote from the server and from each other (figure 1 shows desktop being at a different location than the remote terminal), each set of corresponding apparatuses being for a specific one of a plurality of users of the sets (figure 1 depicts a LAN/WAN environment which use Firewalls #112 connecting multiple users #102 and #134 and connectivity via the Internet (C2, L65) which inherently requires TCP/IP and said LAN/WAN system would inherently be setup to only allow access by each set of corresponding apparatuses being a specific one of a plurality of users of the sets),

Receiving data from a first apparatus in a set (figure 1 shows remote terminal connecting to global server via comm. link #104);

Manipulating the data so that it is usable by a program application in a corresponding second apparatus of the set (C3, L6 to C4, L23 teaches reformatting data from Format A to Format B); and

But is silent on Selectively transferring the manipulated data to the one or more second apparatuses in the set.

The examiner notes that Mendez does teach data being sent (automatically per Abstract) from the remote terminal to the desktop computer via the global server in figure 1. Mendez also teaches "synchronization" which broadly provides automatic/manual updating of files between client and server – this inherently requires the system to understand which "server files" to associate with which "client files" when synchronization occurs. **Segur** teaches (figure 6 and C3, L35-65) that the server analyzes the sender ID which allows the user to select which messages to download. Hence, the examiner interprets Mendez's automatic synchronization of reformatted files between two users combined with Segur's ability to identify the sender of each messages in the receiver's inbox as reading on "selectively transferring manipulated data to the one or more second apparatuses".

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Mendez, such that selectively transferring the manipulated data to the one or more second apparatuses in the set occurs, to provide for automatic transfer of data to only those users within the LAN/WAN when synchronization is possible (eg. when a link is established for the mobile user(s)).

As per **claim 17,** Mendez teaches a system comprising:

A server enabled for access by a plurality of sets of corresponding apparatuses the apparatuses being remote from the server and from each other (figure 1, #106/#112 shows a Global Server/Global Firewall), each set of corresponding apparatuses being for a specific one of a plurality of users of the sets (figure 1 depicts a LAN/WAN environment which use Firewalls #112 connecting multiple users #102 and #134 and connectivity via the Internet (C2, L65) which inherently requires TCP/IP and said LAN/WAN system would inherently be setup to only allow access by each set of corresponding apparatuses being a specific one of a plurality of users of the sets);

The server enabled to receive data from a first apparatus in a set (figure 1, shows remote terminal #102 connecting via comm. link #104 to Global Server #106);

The server enabled to manipulate the data so that it is usable by a program application in a corresponding second apparatus of the set (figure 1 shows Global server #106 connecting to Desktop computer #134 and C3, L6 to C4, L23 teaches reformatting data from Format A to Format B); and

But is silent on the server enabled to selectively transfer the manipulated data to the one or more second apparatuses in the set.

The examiner notes that Mendez does teach data being sent (automatically per Abstract) from the remote terminal to the desktop computer via the global server in figure 1. Mendez also teaches "synchronization" which broadly provides automatic/manual updating of files between client and server – this inherently requires the system to understand which "server files" to associate with which "client files" when

synchronization occurs. **Segur** teaches (figure 6 and C3, L35-65) that the server analyzes the sender ID which allows the user to select which messages to download. Hence, the examiner interprets Mendez's automatic synchronization of reformatted files between two users <u>combined with</u> Segur's ability to identify the sender of each messages in the receiver's inbox as reading on "selectively transferring manipulated data to the one or more second apparatuses".

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Mendez, such that the server selectively transfers the manipulated data to the one or more second apparatuses in the set occurs, to provide for automatic transfer of data to only those users within the LAN/WAN when synchronization is possible (eg. when a link is established for the mobile user(s)).
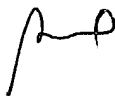
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone number is 703-306-5426. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Trost can be reached on 703-308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Stephen D'Agosta
9-15-04

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